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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,096	03/23/2004	Akihiko Seki	250651US0	1843

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EXAMINER	
RESAN, STEVAN A	

ART UNIT	PAPER NUMBER
1773	

DATE MAILED: 04/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/806,096	SEKI ET AL.	
	Examiner	Art Unit	
	Stevan A. Resan	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-7 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-7 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 23 March 2004 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 4-21-04;6-23-04.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for certain compositions,processed in certain processes, does not reasonably provide enablement for all compositions and processes. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims without undue experimentation.

The skilled artisan is given insufficient direction and guidance in the disclosure to practice the invention commensurate with the present broad claims. "The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation", United States v. Telectronics, Inc., 857 F.2d 778, 8 USPQ 2d 1217, 1223 (Fed Cir. 1988).

Applicants have disclosed only species of compositions and/or structures in an art that is unpredictable, hence requiring complex, time consuming procedures to identify materials, compositions, structures and processes out of the many possibilities in order to obtain the benefits of the invention within the scope of the present claims, i.e. undue experimentation In re Wright 999 F 2d 1557, 1562, 27 USPQ 2d 1510,1513.

"It is not enough that a person skilled in the art, by carrying on investigations along the line indicated in the instant application, and by a great amount of work

eventually might find out how to make and use the instant invention. The statute requires the application itself to inform, not to direct others to find out for themselves." In re Scarbrough, 500 F.2d 560, 565, 182 USPQ 298, 301-02 (CCPA 1974).

There must be a reasonable correlation between the scope of the claims and what is taught in the specification. In re Fisher 427, F2d 833, 839, 166 USPQ 18, 24, CCPA 1970.

The claiming of a previously unidentified property that is inherently present does not necessarily make a claim patentable.

It has been held that where claimed and prior art products are identical or substantially identical in structure or in composition, or are produced by identical or substantially identical processes a case of anticipation or a prima facie case of obviousness has been established and the burden of proof is shifted to applicant to show that prior art products do not necessarily or inherently possess the characteristic of a claimed product whether the rejection is based upon "inherency" under 35 USC 102 or on "prima facie obviousness" under 35 USC 103 jointly or alternately. In re Best 562 F2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977); In re Ludke, 58 CCPA 1159,441 F 2d at 212-13, 169 USPQ 563 (1971); In re Brown, 59 CCPA 1036, 459 F. 2d 531, 173 USPQ 685 (1972).

" When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not". In re Spada. 911 F2d 705, 709, 15 USPQ 2d 1655 (Fed. Cir. 1990).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hattori et al JP 10-011736 in view of Kohno et al US 5443913..

Hattori et al disclose a magnetic recording medium comprising a non magnetic layer on one surface of a non magnetic support, an upper magnetic layer on the lower non-magnetic layer(in the thickness range of claim 5, [0057], and a backcoat layer on the other surface of the non-magnetic support.

Hattori et al do not disclose a SENDUST abrasion volume for the magnetic layer or the backcoat layer.

However Sendust abrasion volume is a test method for measuring durability of a layer. it would have been obvious to one of ordinary skill in the art to optimize the durability of each layer for sliding contact with a magnetic head (magnetic layer) or guide pins (backcoat layer).

Note that the claiming of a previously unidentified property as in claims 1-2 that is inherently present (i.e. material that can be abraded) does not necessarily make a claim patentable as pointed out above.

Hattori et al do not specifically teach surface roughness as in claims 3,4 and 7. However, Kohno et al et al are provided for teaching the desirability of surface roughness in these claimed ranges. (Col 35 lines 7-11). Therefore it would have been obvious to one of ordinary skill in the art to optimize this results effective property to maximize performance.

Furthermore Hattori et al teach that the stabilization of the coefficient of friction is desirable [0057]. Therefore it would have been obvious to one of ordinary skill in the art to optimize of the coefficient of friction as in claim 5

While applicants have shown improved properties in their examples over the comparative examples these results are not commensurate with the scope of the claims.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stevan A. Resan whose telephone number is 571-272-1513. The examiner can normally be reached on Tues-Thurs from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached at 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

STEVAN A. RESAN
PRIMARY EXAMINER